



Atty. Docket No.
182.0016

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

STEVEN L. EIKENBERG

Serial No.: 09/828,601

Group Art Unit: 3732

Filed: April 6, 2001

Examiner: Melba Bumgarner

For: EASY ACCESS DENTAL FIELD OPERATING AND
TREATMENT SYSTEM HAVING OVER-THE-PATIENT
DELIVERY

APPLICANT'S REPLY BRIEF

Applicant respectfully submits this short reply to address the lynchpin of the Examiner's position – that Seidman *et al.* disclose a “portable dental treatment system.”

Applicant respectfully submits that the term “portable dental treatment system” was used and defined in the specification in a manner as understood by one of ordinary skill in the art. Applicant argued that he was acting as his own lexicographer only to the extent the word “portable” was being used inconsistent (in this case as not being coterminous) with its dictionary definition. Applicant did not intend to argue that the term “portable dental treatment system” was being defined in a manner inconsistent or contrary to its meaning in the context of the application as would be understood by one of ordinary skill in the art.

In either case, it is unassailable that in the first three sentences of the specification, the Applicant specifically states that the invention relates to “portable dental treatment systems” and that such systems are systems that can be carried:

Field of the Invention

The present invention relates, in general, to ***portable dental treatment systems***.

Background of the Invention

Dental treatment systems are systems which facilitate the delivery of dental services to patients. **Portable dental treatment systems** are dental treatment systems which have been designed such that they can be compacted and bundled so that a relatively fit person (e.g., a man or a woman) can physically carry the portable dental system.

Specification, page 1, ln 10-18 (emphasis added).

Applicant's specification goes on to describe field environments and other situations where portable dental treatment systems are useful. See Specification at page 1, ln 20 to page 2, ln 6. In the Brief Description of the Drawings, Figures 1A and 1B are specifically described as showing perspective views of a "portable dental treatment system." All of the claims at issue are directed to "a portable dental treatment system." In short, the term "portable dental treatment system" is used consistently throughout Applicant's specification and is used in a manner consistent with the definition Applicant provided in the specification.

In the present case, a system which is merely mobile, e.g., having wheels, is incapable of being used in the environments wherein the "portable" systems of the present invention are intended to be used. One of ordinary skill in the art reading the specification would readily understand that Applicant's invention was an improvement to overcome some of the drawbacks with prior art portable dental treatment systems – not office-type systems such as those described in Seidman *et al.* Accordingly, Applicant respectfully submits that Seidman *et al.* do not disclose a "portable dental treatment system."

Again, the specification and prosecution history make clear that the portable dental treatment systems of the present invention are those that can be carried by a user. "The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines them by implication."

Vitronics Corp. v. Conceptronic, Inc. 90 F.3d 1576, 1582 (citing *Markman v. Westview Instr.*, 52 F.3d 967, 979). If there is a dispute as to the ordinary meaning of claim language, the specification is "the single best guide" to resolve the dispute. *Id.* In this regard, Applicant submits that the specification not only expressly defines the term "portable dental treatment system" but also uses the

term and depicts embodiments that, by implication, require the term "portable" to be understood as capable of being carried. The Federal Circuit has made it clear that the PTO cannot ignore guidance from the specification provided by an Applicant when construing claims:

Some cases state the standard as "the broadest reasonable interpretation" others include the qualifier "consistent with the specification" or similar language. Since it would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description, either phrasing connotes the same notion: as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 44 USPQ.2d 1023, 1027 (Fed. Cir. 1997)(internal citations omitted).

Whether viewed as Applicant being his own lexicographer, or Applicant providing interpretive guidance in the disclosure, Applicant's specification makes it clear that the term "portable dental treatment system" does not include the merely movable office-type dental treatment systems of Seidman *et al.*

In conclusion, when Seidman *et al.* is properly viewed as not disclosing a portable dental treatment system, the Examiner's prior art rejections must fail. Properly viewed, Seidman *et al.* simply disclose another office-type system that does not teach or suggest a modification to portable dental treatment systems to allow for over-the-patient delivery of dental services.

Respectfully submitted,

CAHN & SAMUELS, LLP

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By: W. E. Bradley
William E. Bradley, Esq.
Reg. No. 42,355
Cahn & Samuels, LLP
2000 P St., NW, Ste. 200
Washington, D.C. 20036
Telephone: (202) 331-8777
Fax: (202) 331-3838